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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|------------------------------|------------------|
| 09/819,244 | 03/28/2001 | Satoru Ueda | 450100-03099 | 2106 |
| 20999 | 7590 | 09/08/2006 | | |
| FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151 | | | EXAMINER STRANGE, AARON N | |
| | | | ART UNIT 2153 | PAPER NUMBER |

DATE MAILED: 09/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|------------------------------|--|
| Office Action Summary | Application No. 09/819,244 | Applicant(s) UEDA, SATORU | |
| | Examiner Aaron Strange | Art Unit 2153 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 6/13/06 have been fully considered but they are not persuasive.

2. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Applicant has merely provided a general assertion that the cited references fail to teach a newly added limitation, but fails to explain how the new limitation patentably distinguishes the claim over the currently cited references.

3. With regard to claim 1, and Applicant's assertion that Ng and Zabetian fail to teach the newly added limitation that "said first attorney communication terminal...owned by at least one attorney...in which said attorney provides advice from the standpoint of a law expert by consulting on every electronic mail transmission.", the Examiner respectfully disagrees.

It should be noted that the newly added limitation has not been given patentable weight. Claim 1 claims a system, and the ownership of the terminals or whether the attorney is providing advice has no affect on the physical structure or function of the system. As discussed in previous Office actions, the content of the messages sent and identity of system users do not materially affect the system or any method of using it.

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These types of limitations impart no patentable weight and will not result in claims that may be patentably distinguished from the prior art of record.

Ng suggests use of the system by Attorneys (at least Col 13, Lines 62-65) and it would have been apparent to one of ordinary skill in the art that anyone could use the system taught by Ng and Zabetian to send messages with any contents to anyone else, in any order. The ownership of system elements or the purpose for using the system amount merely to intended use and do not add patentable weight to the claims.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3,5, and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ng (US 6,640,301) in view of Zabetian et al. (6,327,656) in further view of Applicant's Admitted Prior Art.

6. With regard to claim 1, Ng discloses a communication contents certification system for certifying contents of an electronic mail, comprising:

a communication contents certification apparatus (Email web site) (Fig 4, 20')

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having communication contents receiving means for receiving said electronic mail (messages are received through email web site) (Col 6, Lines 42-46), communication contents storage means for storing the contents of said electronic mail (Copies of sent email can be stored at the email web site) (Col 8, Lines 40-42), communication contents transmission means for transmitting said electronic mail (Messages are sent through email web site) (Col 6, Lines 42-46), and charging means for charging a fee associated with use of the communication contents certification apparatus (Col 14, Lines 21-26);

a first party communication terminal coupled to the communication contents certification apparatus (terminal containing browser) (Fig 4, 24) (Col 6, Lines 41-58);

a second party communication terminal coupled to the communication contents certification apparatus (terminal containing email client) (Fig 4, 15) (Col 6, Lines 41-58);

a first attorney communication terminal coupled to the communication contents certification apparatus (Col 13, Lines 62-65);

a second attorney communication terminal coupled to the communication contents certification apparatus (Col 13, Lines 62-65); wherein:

the electronic mail is transmitted from a first party communication terminal to at least one of an attorney communication terminal and another of the party communication terminals such that the electronic mail is routed to the communication contents certification apparatus and the communication contents certification apparatus obtains authentication information for the electronic mail, and stores the contents of the electronic mail (email is sent via the certification apparatus) (Col 8, Lines 19-29), and

a reply message in response to a received electronic mail is prepared (at least Col 10, Lines 25-27; Fig 8D).

Ng fails to specifically disclose obtaining an identification and password of a sending party to authenticate the contents of the electronic mail, preparing a reply message with reference to a comment provided from one of the attorney communication terminals, or charging means for charging at least one of the parties for authenticating and/or certifying the contents of the electronic mail.

Zabetian discloses a similar system for certifying electronic mail and teaches authenticating the electronic mail based on an identification (source address) (Col 6, Lines 38-45) and password of the sending party (Col 6, Lines 63-64). This would have been an advantageous addition to the system disclosed by Ng since it allows the sender of the message to be positively identified, ensuring that the message actually came from a particular person.

The Examiner took Official Notice of the following in the Office action of 11/15/2005, and Applicant failed to traverse this assertion in the subsequent response of 2/7/2006. Therefore, it has been taken that Applicant admits that it would have been apparent to one of ordinary skill in the art at the time the invention was made to charge a sender or receiver a fee for certifying the electronic mail.

While Ng fails to specifically disclose preparing the reply message with reference to a comment provided from one of the attorney communication terminals, it is apparent that the content of the reply message does not materially affect the claimed communication contents certification system, or impart any functionality to it. The

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content of the messages delivered using the claimed system is merely a design choice of the users of the system. It would have been apparent to one of ordinary skill in the art that a user could send messages containing anything and with reference to anything they choose using the system taught by Ng and Zabetian.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use an identifier/password combination to authenticate the contents of an electronic mail, allow message replies with reference to attorney contents and charge a fee to users of the certification system.

NOTE: For further discussion of claim 1, see ¶4 above. Since the newly added limitations have not been given patentable weight, they have been omitted from the text of the rejection. In the event that the limitations were given patentable weight, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to allow attorneys to use the system to provide legal advice for at least the reasons discussed in ¶4.

7. With regard to claim 2, while the system disclosed by Ng shows substantial features of the claimed invention (discussed above), including a GUI (Col 8, Lines 20-22), a party button display section for selecting electronic mail communication with the second party communication terminal wherein the first party communication terminal is adapted to transmit the electronic mail as a function of input to the GUI (Clicking on "Authenticated Send" button sends message to second party via certification

apparatus)(Col 8, Lines 25-29), it fails to specifically disclose an attorney button display section for selecting electronic mail communication with said first attorney communication terminal.

However, at the time the invention was made, it would have been obvious to one of ordinary skill in the art to include an attorney button display because Applicant has not disclosed that a dedicated attorney button display provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well by specifying the attorney's email address and using the "Authenticated Send" button as disclosed by Ng (Col 8, Lines 19-29 and Fig 8A-8D) because both methods perform the required task of sending the message to the user's attorney via the certification apparatus equally well.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system disclosed by Ng to obtain the invention as specified in claim 2.

8. With regard to claim 3, Ng further discloses that the contents of the electronic mail relate to a contract matter (Terms of Sale) between said first party and said second party (Fig 8A-8D).

9. With regard to claim 4, Zabetian further discloses a method of confirming the reception of an electronic mail by having the recipient notify the certification requester

(the certification apparatus in this case) upon successful receipt of the message.

Zabetian discloses that this can be accomplished through a conventional return receipt or through an active login procedure to the email web site (Col 11, Line 63 to Col 12, Line 16).

10. With regard to claim 5, Ng further discloses that the electronic is encrypted (Col 14, Lines 45-47).

11. With regard to claim 6, Zabetian further discloses several methods of registering users for email service so their identity can be confirmed (Col 6, Line 54 to Col 7, Line 3).

12. Claims 7 and 8 are rejected for the same reasons as claims 1 and 3, since they recite subject matter which is wholly contained within those claims.

13. Claim 9 is rejected for the same reasons as claim 1, since it recites subject matter which is wholly contained within claim 1. Since the system disclosed by Ng is executed on computers, a computer readable recording medium holding the software to perform the method of claim 9 is inherent.

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron Strange whose telephone number is 571-272-3959. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AS
8/29/06



KRISNA LIM
PRIMARY EXAMINER